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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,800

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Richard Farrar

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MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3775

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,800	Applicant(s) FARRAR ET AL.	
	Examiner Nicholas Woodall	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 09/12/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millard (U.S. Patent 6,712,824) in view of Muller (U.S. Publication 2001/0018589).

Regarding claim 1, Millard discloses a device comprising a guide block including a fixation part and a guide part mounted on the fixation part (see Figure 4 of the reference). The guide part includes at least one structural feature capable of engaging a surgical tool to ensure the tool is located appropriately relative to the tissue of a patient, the guide block includes at least two drives (14 and 16) capable of adjusting the position of the guide part relative to the fixation part in at least two degrees of freedom (column 4 lines 12-24), and the guide part includes at least one position indicator (10) fixed relative to the guide part. Millard discloses the device further comprises at least one position

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monitor capable of tracking the location of the position indicator (column 5 lines 21-25).

Regarding claim 2, Millard discloses a device wherein the guide block includes at least three drives capable of adjusting the guide part relative to the fixation part in at least three degrees of freedom (14, 16, and 11; see column 5 lines 38-43). Regarding claim 3, Millard discloses a device wherein the fixation part includes a housing which is hollow and in which the drives are located inside the housing. Regarding claim 4, Millard discloses a device wherein the guide block includes connector shafts which extend from the fixation part to the guide part, which are moved relative to the fixation part by respective drives to cause the location of the guide part to be adjusted. Regarding claim 5, Millard discloses a device wherein the fixation part further includes means for adjusting the drives (5, 8, and 15), which are accessible from outside the housing. Regarding claim 6, Millard discloses a device wherein the structural feature comprises a guide surface capable of being engaged by a blade to define the appropriate alignment for a cut. Regarding claim 7, Millard discloses a device wherein the structural feature comprises an opening capable of receiving a drill bit. Regarding claims 8 and 9, Millard discloses a device wherein the fixation part includes a plurality of openings capable of receiving fasteners to fix the part to the tissue of the patient. Millard fails to disclose the device further comprising a signal generator connected to the drives capable of generating position signals transmitted to the drives to adjust the guide part. Muller teaches a device comprising a signal generator, i.e. a computer, coupled to drives in order to automatically adjust the guides of the device (page 1 paragraph 018). It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to manufacture the device of Mallard further comprising a signal generator coupled to the drives in view of Muller in order to automatically adjust the guide part.

4. Claims 1, 2, 4-6, and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pohl (U.S. Patent 4,703,751) in view of Millard (U.S. Patent 6,712,824) and Muller (U.S. Publication 2001/0018589).

Regarding claim 1, Pohl discloses a device comprising a fixation part that is capable of being directly fixed to tissue, a guide part having at least one structural feature capable of engaging a surgical tool, and at least two drives capable of adjusting the guide part relative to the fixation part in at least two degrees of freedom. Regarding claim 2, Pohl discloses a device comprising at least drives for adjusting the position of the guide part relative to the fixation part. Regarding claim 4, Pohl discloses a device further including connector shafts that extend from the fixation part to the guide part and move relative to the fixation part by respective ones of the drives to cause the location of the guide part to be adjusted. Regarding claim 5, Pohl discloses a device wherein the fixation part includes a means for adjusting the drives that are accessible from outside the housing. The applicant invokes 35 U.S.C. 112 6th paragraph in claim 5, which requires the examiner to reference the specification for structure that the applicant designates for performing the function of “adjusting the drives which are accessible from outside the housing”. The applicant designates knobs, on page 3 of the specification, as being capable of performing the “means for” functional limitations of claim 5. Pohl discloses knobs being used for a similar function and therefore discloses the limitations of claim 5. Regarding claim 6, Pohl discloses a device wherein the guide part comprises

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a guide surface that is capable of being engaged by a blade. Regarding claims 8 and 9, Pohl discloses a device wherein the guide block has a plurality of openings extending through capable of receiving a fastener. Regarding claim 10, Pohl discloses a device in which at least one of the drives includes a threaded shaft on one of the fixation part and the guide part, and a threaded bore in the other of the fixation part and the guide part in which the threaded shaft can be received by the thread bore and the guide part can be adjusted relative to the fixation part by rotating the threaded shaft relative to the threaded bore. The examiner is interpreting the reference wherein the screw (86) extends through the slot (66) and into a threaded bore (68). By rotating the screw (86), the surgeon is capable of loosening the guide part from the fixation part, so the guide part maybe rotated relative to the fixation part. Once the guide part has been positioned the surgeon can then tighten the screw (86) into the threaded bore (68). Regarding claim 11, Pohl discloses a device wherein at least one of the drives includes a knob to cause rotation between the treaded shaft and the threaded bore. Regarding claim 13, Pohl discloses a device wherein at least one of the drives includes a flexible shaft. The examiner is interpreting flexible to mean any degree of flexibility, and all the shafts of the drives are capable of being flexed. Pohl fails to disclose the device further comprising at least one position indicator fixed relative to the guide part with at least one position monitor capable of tracking the location of the position indicator and a signal generator coupled to the drives by electric motors capable of generating position signals transmitted to the drives to adjust the guide part. Millard teaches a device further comprising at least one position indicator with at least one position monitor to properly

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position and orient the device (column 5 lines 21-25). Muller teaches a device further comprising a signal generator, i.e. a computer, coupled to the drives by electric motors, i.e. servo-motors, capable of generating position signals transmitted to the drives to adjust the guide part in order to automatically adjust the guide part (page 1 paragraph 018). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Pohl further comprising at least one position indicator with at least one position monitor in view of Millard and a signal generator in view of Muller in order to properly position and orient the device and to automatically adjust the guide part.

Response to Arguments

Applicant's arguments filed 09/12/2008 have been fully considered but they are not persuasive. The applicant's argument that the Muller reference teaches away from the use of the servo motors for moving the setting equipment, i.e. guides, because only one paragraph discusses this idea is not persuasive (see page 4 lines 3-5). The amount of disclosure in a reference is irrelevant. The reference teaches using the servos to move the setting equipment, i.e. guides, in paragraph 018 and therefore can be used to teach modifying other references to motorize the setting equipment, i.e. guides. The applicant's argument that the Muller reference does not provide how to incorporate the servo motors into a guide block system is not persuasive. The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Furthermore, it has been held

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that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192. The applicant's argument that the Muller reference only teaches using servo motors in the cutting instrument is not persuasive. As outlines above, the Muller reference teaches using the servo motors to move the setting equipment, i.e. guides, in paragraph 018. The applicant did not amend the claims and the examiner did not provide any new grounds of rejection making this office action **FINAL**.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/

Examiner, Art Unit 3775

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733